

Patent Application No. 10/083,250
Attorney Docket No.: 52493.000251

REMARKS

The Office Action has been received and carefully considered. Claims 30-36 and 45-59 are pending in this application. By this Amendment, claims 30, 55, 58 and 59 are amended.

No new matter has been added by this Amendment.

Reconsideration of the current rejections in the present application is respectfully requested based on the following remarks.¹

A. The Rejections Under 35 U.S.C. 112, first and second paragraphs

In paragraph 8, the Office Action rejects claims 30-36 and 45-58, 59 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Office Action alleges the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Also, in paragraph 11, the Office Action rejects claims 30-36 and 45-59 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In response to the rejections and in order to expedite prosecution of the patent application, the claims are amended.

In view of the foregoing, it is respectfully requested that the aforementioned rejections under 35 U.S.C. 112 be withdrawn.

¹ As Applicant's remarks with respect to the rejections in the Office Action are sufficient to overcome such rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

Patent Application No. 10/083,250
Attorney Docket No.: 52493.000251

B. The 35 U.S.C. 103 Rejection

On page 6 of the Office Action, claims 30-36 and 45-59 are rejected under 35 U.S.C. § 102(e) as being anticipated by Dellinger (U.S. Patent No. 7,089,201) in view of in view of Arena et al (US 20020184129). This rejection is hereby respectfully traversed.

As set forth in M.P.E.P 706.02(j), 35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. M.P.E.P 706.02(j) indicates that after indicating that the rejection is under 35 U.S.C. 103, the Examiner should set forth in the Office Action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

M.P.E.P 706.02(j) references the well known requirements of *Graham v. John Deere*. Further, M.P.E.P 706.02(j) notes that it is important for an Examiner to properly communicate the basis for a rejection so that the issues can be identified early and the Applicant can be given fair opportunity to reply.

On pages 6-8, the Office Action sets forth various assertions in support of the proffered 35 U.S.C. 103 rejection. In particular, on page 7, lines 9-15, the Office Action asserts

... Dellinger teaches an adjustment module for comparing the periodic retirement income payment amount and the guaranteed minimum periodic retirement income payment amount, and for outputting to the user at least the guaranteed minimum periodic retirement income payment amount, **with the adjustment module storing a balance in**

Patent Application No. 10/083,250
Attorney Docket No.: 52493.000251

an adjustment account if the periodic retirement income payment amount is less than the guaranteed minimum periodic retirement income payment amount (see at least col. 8, lines 35-50, col. 8, line 66 - col. 9, line 5). Dellinger does not specifically teach wherein the equity module determines that that payment amount. However, Arena teaches wherein a periodic retirement income payment amount is determined, by the equity module, to be greater than, equal to, or less than a guaranteed minimum periodic retirement income payment amount, such determination performed based on whether the income generating payments received are received according to a payment schedule (see at least paragraph 47). ...

(emphasis added)

Applicant respectfully submits that such assertions are unsupported. In the referenced portion of Dellinger, Dellinger describes:

Another illustrative example follows, using a prospective formula. Again, this is merely one example of an approach the administration of which is covered under this invention to handle variable income benefits in other than the conventional manner described earlier. In this approach, a guaranteed minimum variable income benefit is established below which the benefit payment will not fall. However, in the event the benefit payment calculated without regard to the minimum falls below the minimum benefit payment guaranteed, a portion of **the variable annuity benefit reserve held by the insurer** will be liquidated in an amount sufficient to cover the shortfall. This will result in reduced benefits in the long term when performance of the funds might otherwise dictate a larger benefit payment.

(emphasis added)

However, of note, such disclosure of Dellinger fails to describe manipulation of a "balance", as recited in claim 30. Rather, such disclosure of Dellinger simply describes liquidation of a reserve held by the insurer.

Further, claim 30 is amended to further recite that the recited balance is in particular associated with the user and the guaranteed minimum periodic retirement income payment amount. That is, claim 30 recites:

an adjustment module, tangibly embodied on a computer readable medium, for comparing the periodic retirement income payment amount and the guaranteed minimum periodic retirement income payment amount, and for outputting to the user at least the guaranteed minimum periodic retirement income payment amount, with the adjustment module storing a balance, associated with the user and the guaranteed minimum periodic retirement income payment amount, in an adjustment account upon

Patent Application No. 10/083,250
Attorney Docket No.: 52493.000251

determining the periodic retirement income payment amount is less than the guaranteed minimum periodic retirement income payment amount.

(emphasis added)

In contrast, Dellinger describes (column 8, lines 44-45) that the variable annuity benefit reserve is held by the insurer. Dellinger fails to describe that the variable annuity benefit reserve is in particular associated with the user.

Relatedly, looking to the referenced teachings of Dellinger at column 8, line 65 - column 9, line 3; Fig. 5; and Dellinger at column 6, lines 31-35, Applicant respectfully submits that "reducing the number of units used to calculate future benefit payments, as described by Dellinger, is simply a fundamentally different concept vis-à-vis that claimed by Applicant. That is, looking at Fig. 5 and the first row example, the shortfall amount is 0.00, while the corresponding "reduced units" is 1,500.00. Accordingly, Applicant submits that the claimed contingency of "if the periodic retirement income payment amount is less than the guaranteed minimum periodic retirement income payment amount" is simply not taught by Dellinger.

Applicant submits that Dellinger fails to teach the features relied upon in the 35 U.S.C. 103 rejection. As a result, Applicant submits that the 35 U.S.C. 103 rejection is deficient

For at least these reasons, Applicant respectfully submits that claim 30 is allowable over Dellinger. Independent claims 55, 58 and 59 are allowable for similar reasons.

Regarding claims 31-36, 45-54 and 56-57, these claims are variously dependent upon independent claims 30, 55, 58, and 59. Thus, since the independent claims should be allowable as discussed above, the dependent claims should also be allowable at least by virtue of their dependency on such independent claims. Moreover, these claims recite additional features which are not disclosed, or suggested, by the applied art taken either alone or in combination.

Patent Application No. 10/083,250
Attorney Docket No.: 52493.000251

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection be withdrawn.

C. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees and additional claim fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

By:


James R. Miner
Registration No. 40,444

HUNTON & WILLIAMS, LLP
1900 K Street, NW
Washington, D.C. 20006
Tel. (202) 955-1500
Fax (202) 778-2201

Dated: **June 15, 2010**